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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,439	06/30/2003	Peter J. Kight	23952-0059	7145
72386	7590	10/05/2007		
SUTHERLAND II SUTHERLAND, ASBILL & BRENNAN, LLC 999 PEACHTREE STREET ATLANTA, GA 30309			EXAMINER ALVAREZ, RAQUEL	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 10/05/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/608,439

Applicant(s)

KIGHT ET AL.

Examiner

Raquel Alvarez

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date 2/5/04 2/4/04

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to communication filed on 6/3/2003.
2. Claims 1-16 are presented for examination.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6, 8 and 34-57 of copending Application No. 09/795,314. Although the conflicting claims are not identical, they are not patentably distinct from each other because the current application further recites the second subscriber being activated for only electronic payment. Official Notice is taken that it is old and well known for second subscriber to be activated for only electronic payment of bills of the second subscriber without

verification of the received subscriber information because such a modification would allow the payor to make his electronic payments freely without requiring the need to contact the biller to verify the request.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan (5,699,528 hereinafter Hogan) in view of Lawlor et al. (5,220,501 hereinafter Lawlor).

With respect to claims 1, 4, 9, 12, 16 Hogan teaches a method of activating billers for subscribers for electronic presentment of bills and for electronic payments (Abstract). Receiving first biller information identifying a first of a plurality of billers and first subscriber information which the first biller associates with a first subscriber and second biller information identifying a second of the plurality of billers and second subscriber information which the second biller associates with the second subscriber (i.e. receiving a plurality of bills from a plurality of companies. Different portions or different pages represent billing information for first payor, second payor, third payor, etc.)(col. 4, lines 53-67);

Transmitting, to the first identified in the received first biller information, a request for verification of validity of the received first subscriber information and receiving, from the first biller, the verification of the validity of the first subscriber information responsive to the transmitted verification request (i.e. verifying with the biller that the information received from the payor/subscriber is correct such as the name, address, telephone number and social security number)(col. 5, lines 22-35); and

Activating the first subscriber for electronic presentment of bills of the first biller based on the received verification of validity (col. 5, lines 22-43)

With respect to the second subscriber being activated for only electronic payment of bills without verification of the received second subscriber information. Lawlor teaches the user utilizes a personal computer to communicate bill payment requests to a central computer operated by a bill-paying service provider. The central computer analyzes and processes the requests which are typically for many payments at a time. The information about these payments including scheduled payment dates is stored in a database in the central computer. On the scheduled payment dates, the central computer generates and communicates electronic funds transfer requests through an automated clearing house (ACH) or automatic teller machine (ATM) network to the bank with which the user has an account, thereby debiting the user's account for the payments. The central computer then distributes the funds received to the appropriate payees. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included in the system of Hogan for the second subscriber to be activated for only electronic payment of bills of the second

Art Unit: 3622

subscriber without verification of the received subscriber information because such a modification would allow the payor to make his electronic payments freely without requiring the need to contact the biller to verify the request.

With respect to claims 2-3, 7,10-11, 15, Hogan further teaches receiving payment information which a financial institution associates with a payment account and activating the electronic payments based on the received information (i.e. the payor can activate a checking account payment method and make his electronic payments every month using that method)(see Figure 4).

With respect to claims 5-6, 13-14, Hogan further teaches transmitting, to the first subscriber and to the second subscriber, a list identifying multiple of the plurality of billers (see Figure 10); wherein the first biller is a first of the multiple billers and wherein the received first biller information is indicative of a selection of the first biller)(see Figure 10) ; the second biller paying multiple billers and the second biller information being typed by the second subscriber. Lawlor teaches (i.e. a subscriber can add a biller by selecting new payees and adding the information)(see Figure 3, 205).

Claims 8 and 15 further recite the second subscriber receiving a list identifying a plurality of billers some which have and some which do not have bills available for electronic presentment and the second subscriber is activated for only electronic payment of bills of the second biller based on the received second payment information.

Official Notice is taken that it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included identifying the bills that have bill presentments and the ones that don't and activating the users for only bill payments on the billers that don't have bill presentment in order to activate the users for the correct billing methods.

Point of contact

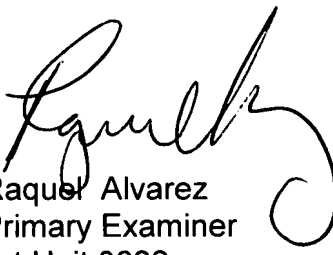
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w. Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/608,439
Art Unit: 3622

Page 7



Raquel Alvarez
Primary Examiner
Art Unit 3622

R.A.
8/28/2007